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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,314	04/26/2001	Ksenia A. Landa	3691-122	5662

23117 7590 06/16/2003

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EXAMINER

VINCENT, SEAN E

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 06/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,314

Applicant(s)

LANDA ET AL.

Examiner

Sean E Vincent

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 27-30 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-26 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-12 is/are rejected.
- 7) ☒ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-26, drawn to a method, classified in class 65, subclass 134.3.

II. Claims 27-30, drawn to glass composition, classified in class 501, subclass 70.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product may be made by a sol-gel process, furthermore the process claims do not require the composition of claims 27-30.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Joseph Rhoa on October 22, 2002 a provisional election was made without traverse to prosecute the invention of group I, claims 1-26.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 27-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

6. Applicant is advised that should claim 7 be found allowable, claim 12 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Jones '621 (WO 96/07621). The features of applicant's claims can be found in the examples of Jones '621, especially example 17.

9. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Pavlish (US 2414413). The features of applicant's claims can be found in the tables in column 3 of Pavlish.
10. Claims 1, 2, 7-9 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Jones '867 (US 5346867). The features of applicant's claims can be found in col. 3, lines 50-60 and Table V. It is the position of the examiner that the disclosure of known volatilization amounts of 85-90% suggested retention percentages of 10-15% and that "~300% increased selenium retention" would therefore suggest improved retention percentages of 30-45%.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones '867 in view of Longobardo (US 5385593).

14. Jones '867 did not teach the use of selenium oxides to supply at least part of the selenium to the glass composition. Longobardo taught that it was known to use Na_2SeO_3 to supply selenium to glass melts. (see col. 5, lines 28-30) It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use Na_2SeO_3 in the process of Jones '867 because Longobardo taught that it was well known to do so. The selection of any particular proportion within the range taught by the reference(s) would appear to involve only routine testing well within the scope of the worker in the art, see *In re. Aller et al.*, 105 U.S.P.Q. 233, 42 C.C.P.A. 824.

15. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jones '867 in view of Seto et al (US 5952255).

16. Jones '867 did not teach that chromium oxide could be part of the colorant portion. Seto et al taught that it was well known in the art to incorporate chromium oxide in a colorant portion of a solar control glass. (see col. 4, lines 16-19). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate small amounts of chromium in the colorant portion of Jones '867 because Seto et al taught that it was well known in the art to do so. The selection of any particular proportion within the range taught by the reference(s) would appear to involve only routine testing well within the scope of the worker in the art, see *In re. Aller et al.*, 105 U.S.P.Q. 233, 42 C.C.P.A. 824.

Allowable Subject Matter

17. Claims 13-26 are allowed.
18. Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
19. The following is a statement of reasons for the indication of allowable subject matter:
The prior art does not teach or fairly suggest the addition of a sufficient quantity of Epsom salts in selenium containing glasses to cause the glass to retain at least 30% of the originally added selenium. Applicant's have admitted in col. 3, lines 56-63 of US Pat. 6521558 that Epsom salts were known conventional refining aids in the making of gray glasses containing selenium. However, the quantity of Epsom salts was not credited with increased selenium retention during melting.

Conclusion

20. The prior art made of record and not relied upon is cited to further show the state of the art.
21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean E Vincent whose telephone number is 703-305-3607. The examiner can normally be reached on M - F (8:30 - 6:00) Second Monday Off.

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22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

23. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

A handwritten signature in black ink, appearing to read 'S Vincent', with a stylized flourish at the end.

Sean E Vincent
Primary Examiner
Art Unit 1731

S Vincent
June 12, 2003